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APPLICATION, NO.	FILING DATE	FIRST NAMED INVENTOR	A	TTORNEY DOCKET NO.
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	1/ // 211 /14			
Office Action Summary	C/111, +14 / Minus		. 1 .ct.	
	Examiner		Group Art Unit	
	Set armet &		(6,56)	
—The MAILING DATE of this communication app	ears on the cover sheet	beneath the corr	respondence address	
iod for Response		2		
HORTENED STATUTORY PERIOD FOR RESPONSE IS ILING DATE OF THIS COMMUNICATION.	S SET TO EXPIRE)MONTH(S) FROM THE	
Extensions of time may be available under the provisions of 37 CF from the mailing date of this communication. If the period for response specified above is less than thirty (30) days from the period for response is specified above, such period shall, by Failure to respond within the set or extended period for response we	tys, a response within the state default, expire SIX (6) MONTH	utory minimum of thir HS from the mailing d	ty (30) days will be considered timely. late of this communication .	
tus				
Responsive to communication(s) filed on			(=	
This action is FINAL .				
Since this application is in condition for allowance exce accordance with the practice under <i>Ex parte Quayle</i> , 1	ept for formal matters, pro 935 C.D. 1 1; 453 O.G. 2	osecution as to that 13.	ne merits is closed in	
position of Claims				
Claim(s)	is/are pending in the application.			
Of the above claim(s)	is/are wi	is/are withdrawn from consideration.		
Claim(s)	is/are allowed.			
Claim(s)	is/are rejected.			
Claim(s)		is/are ob	jected to.	
Claim(s)				
plication Papers		requirem	nent.	
☐ See the attached Notice of Draftsperson's Patent Drav	ving Review, PTO-948.			
☐ The proposed drawing correction, filed on	is []approved	l disapproved.		
The drawing(s) filed on is/are ob	jected to by the Examiner			
The specification is objected to by the Examiner.				
The oath or declaration is objected to by the Examiner	* ,			
ority under 35 U.S.C. § 119 (a)-(d)				
Acknowledgment is made of a claim for foreign priority I All I Some* I None of the CERTIFIED copies I received.	of the priority documents	have been	·	
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Application Control Number: 09/211,794

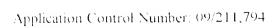
Art Unit: 1635

DETAILED ACTION

- The Official Action previously mailed on 03/30/00 to Pennie and Edmonds was apparently not received by Applicant in view of the Change of Address and Status Inquiry—Therefore, the Action is being re-sent with a new time period for response beginning with the receipt of this Official Action.
- 2. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications. Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.
- 3. The status of the parent Application 08/754,580, filed November 21,1996, needs to updated in the first line of the specification to reflect that this Application has now been patented

Claim Rejections - 35 USC § 112

4. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.



Art Unit 1635

Claims 1-19 are indefinite for the language "capable of" since such language defines a latent characteristic of the claimed invention, the metes and bounds of which are not clear.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Orman*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 5,849,902. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The instant claims differ from the claims of '902 since the instant claims specify the 11-59 bases are divided by an Rnase H-activating region and the claims of '902 specify the 5' terminal or 3' terminal of the oligonucleotide is attached to the an Rnase -H activating region. Absent evidence to the contrary, it would have been obvious to one of ordinary skill in the art that Rnase

Application Control Number: 09/211,794

Art Unit 1635

H functions by recognizing and cleaving RNA/DNA duplexes and said activation region of "902 would render obvious its application anywhere in an oligonucleotide.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Mary M. Schmidt*, whose telephone number is (703) 308-4471.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *John LeGuyader* may be reached at (703) 308-0447

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Analyst, *Katrina Turner*, whose telephone number is (703) 305-3413

M M Schmidt January 1, 2001 REMY YUCEL, PH.D
PRIMARY EXAMINER